

REMARKS/ARGUMENTS

Favorable reconsideration and allowance of the present patent application are respectfully requested in view of the foregoing amendments and the following remarks.

Claims 1-20 are pending in this application.

35 U.S.C. §102 & 103 Rejections

Claims 1-20 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Bojerd (U.S. Patent No. 5,946,622) in view of Baum et al. (U.S. Patent No. 6,510,319) and Weaver Jr., et al. (U.S. Patent No. 5,917,811) and Tiedemann Jr., et al. (U.S. Patent No. 5,999,816).

Regarding claims 1 and 11, the Office Action states that the Baum reference abstract "is interpreted by the examiner to read on power transmission is not lowered". Applicant respectfully disagrees with this characterization. As discussed in Applicant's prior response, Baum explicitly teaches to lower the gain of the base station. This is expressly taught in column 2, lines 21-29 of Baum, which follows (with emphasis added).

More particularly, when an overload status is attained by a base station, it informs the SDU of the actual value of the power gain level applied and its power overload status. Once the overload status is detected, no further gain increases by the SDU are allowed until the power overload condition is retracted. **Gain decreases, however, are allowed.** That is, the subsequent **gain values can be less than or equal** to the value returned with the most recent response indicating overload.

As expressly stated in the above-referenced section, Baum teaches to decrease the gain of the forward link. Applicant fails to understand how the abstract can be interpreted by the Office Action "to read on power transmission is not lowered" (page 2 of Office Action dated October 29, 2003). Applicant respectfully submits that the Office Action's interpretation of Baum is in direct contradiction to Baum's express teachings. Therefore, the Baum reference as applied cannot teach the features alleged by the Office Action.

Further, the Office Action now acknowledges that Baum does not disclose reverse link power control. However, the Office Action does not suggest why one of ordinary skill in the art would look to the alleged teachings of controlling interference between base stations to obtain teachings as to how to control the power level from a mobile terminal. Further, as noted above the Office Action's "teachings" regarding the base station power control are in direct contradiction to the Baum reference itself.

Further, regarding the newly applied Tiedemann Jr., et al. (Tiedemann), the Office Action again ignores the express teaching of this reference, which discloses in column 17, lines 51-60 the following (with emphasis added).

Regarding the reverse link power control, the transmission power of the mobile station is controlled in a closed loop fashion by comparing the received energy of a group of symbols in the reverse link frame to a threshold value. If the received energy of a group of symbols is less than the threshold value, the mobile station is instructed to increase its transmission power. **If received energy of a group of symbols is above the threshold value, the mobile station is instructed to decrease its transmission power.**

As expressly stated in the above-referenced section, Tiedemann teaches a conventional closed loop control which allows for the control power to be lowered, which is in direct contradiction to the functionality the Office Action alleges Tiedemann supports.

As stated in MPEP § 2143.01, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). Neither Bojerd, Baum, Weaver, Tiedemann nor the combination of these references discloses the features of Applicant's claimed combinations as noted above. Therefore, these references do not render Applicant's claimed combinations obvious as alleged by the Office Action.

Additionally, as stated in MPEP § 2141.02, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). As confirmed in MPEP § 2145, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 218 USPQ 769, 779 (Fed. Cir. 1983). Clearly, in applying the Baum, Weaver and Tiedemann references, the Office Action completely disregards the teachings of these references that expressly teach away from the claimed features. Accordingly, these references do not render Applicant's claimed combinations obvious as alleged by the Office Action.

Further, Applicant submits that one of ordinary skill in the art would not have been motivated to modify the systems of Bojerd, Baum, and Weaver to arrive at Applicant's claimed combinations absent impermissible hindsight reference to Applicant's specification. The Office Action merely compiles a list of "alleged teachings" and frames them with in the context of Applicant's disclosure. Applicant respectfully submits that there is no teaching or suggestion in the references that support this amalgamation of these "alleged teachings", which are further contradicted by the references themselves.

SUMMARY

For at least the foregoing reasons and the reasons set forth in Applicant's response of September 10, 2003 (which brevity, Applicant expressly incorporates herein without a literal rendition of those arguments in this response), it is respectfully submitted that claims 1, 11 and 20 are distinguishable over the applied art. The remaining dependent claims are allowable at least by virtue of their dependency on the above-identified independent claims. See MPEP § 2143.01. Moreover, these claims recite additional subject matter, which is not suggested by the documents taken either alone or in combination.

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Docket No. K-0214

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney, **Carl R. Wesolowski**, at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

Respectfully submitted,
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